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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/465,402	12/17/1999	SUBBARAO V. PONAKALA	2047.114	8828

7590 06/03/2003

The NutraSweet Company  
200 World Trade Center  
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Chicago, IL 60654

EXAMINER

WONG, LESLIE A

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 06/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

AS-20

# Office Action Summary

Application No.  
09/465,402

Applicant(s)  
Ponakala et al.

Examiner  
Leslie Wong

Art Unit  
1761



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on May 8, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 19-24 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 8, 2003 has been entered.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nofre et al (5480668).

Nofre et al disclose N-substituted derivatives of aspartame and that N-[N-(3,3-dimethylbutyl)-L- $\alpha$ -aspartyl]-L-phenylalanine 1-methyl ester is an extremely potent sweetening agent, where the agent may be used by itself or in combination with other sweetening agents (see entire patent, especially column 6, lines 16-26). Nofre et al also disclose that the agent may be used in a variety of products including chewing gum (see column 1, lines 10-14).

The claims differ as to the amounts employed and the specific use in chewing gums.

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In the absence of a showing to the contrary, the amounts employed are seen to be no more than optimization which is well-within the skill of the art, see *In re Boesch* 205 USPQ 215.

The use of intense sweeteners in chewing gum products is notoriously well-known and the selection of chewing gum product is well-within the skill of the art and merely a matter of choice.

Once the art has recognized the use of N-[N-(3,3-dimethylbutyl)-L- $\alpha$ -aspartyl]-L-phenylalanine 1-methyl ester as a sweetening agent, then the use and manipulation of amounts for use in chewing gums would be no more than obvious and well-within the skill of the ordinary worker. The observation of still another beneficial result in an old process cannot form the basis of patentability, see *In re Jones* 1941 CD 686.

It would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to use the sweeteners of Nofre et al in chewing gum products because it is well-known in the art that N-[N-(3,3-dimethylbutyl)-L- $\alpha$ -aspartyl]-L-phenylalanine 1-methyl ester is a powerful sweetening agent for use in foods and beverages.

The declaration under 37 CFR 1.132 filed November 8, 2002 is insufficient to overcome the rejection of claims 19-24 based upon Nofre et al as set forth in the last Office action for the following reasons.

1) The showing is not commensurate in scope with the claims. Applicant claims "an amount effective to sweeten" whereas the showing appears to be specific for 100 ppm neotame.

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2) It is not seen where Applicant actually shows “wherein between 6 and 10 minutes of chewing time, the average sweetness intensity loss rate is less than 0.3 intensity units per minute.”

3) The prior art is directed to neotame as is claimed. Applicant does not refer to the prior art. It is not seen where Applicant has established unexpected results for the claimed invention.

In the absence of unexpected results, it is not seen how the claimed invention differs from the teachings of the prior art. Applicant's claims are drawn to a combination of known components which produces expected results, see *In re Kerkhoven* 205 USPQ 1069 and *In re Gershon* 152 USPQ 602.

All of the claim limitations and arguments have been considered. None of them are seen as serving as basis for patentability.

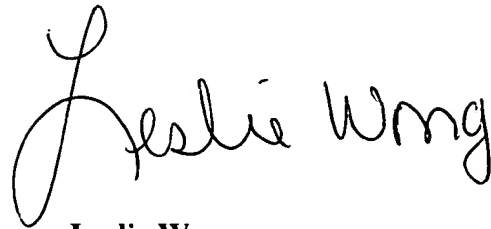
No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Wong whose telephone number is (703) 308-1979. The examiner can normally be reached on Tuesday-Friday.

The fax number for this Group is (703) 872-9310 for non-final responses and (703) 872-9311 for after-final responses.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink that reads "Leslie Wong". The signature is written in a cursive style with a large, looping initial "L".

**Leslie Wong**  
**Primary Examiner**  
**Art Unit 1761**

LAW  
June 2, 2003